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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

SHITARA, K. et al.

Atty. Ref.: 249-243

Serial No. 10/009,723

Group: 1641

Filed: December 17, 2001

Examiner: GRUN, James Leslie

For: DIAGNOSTIC AGENT AND THERAPEUTIC AGENT FOR DISEASE RELATED TO
MONOCYTE AND MACROPHAGE

* * * * *

October 20, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

SUPPLEMENTAL SUBMISSION

Supplemental to the Request filed September 29, 2004, and further to a teleconference between the undersigned and the Examiner on October 13, 2004, the Examiner is again requested to return an initialed copy of the PTO-1449 Form filed December 17, 2001, which listed the documents cited in the International Search Report issued in connection with International Application No. PCT/JP00/03957. As noted in the Request filed September 29, 2004, the partially-initialed copy of the PTO-1449 Form received with the Office Action of September 21, 2004, includes a lined-through WO 98/22626 as well as the additional document BIOSIS No. 199799777801, each of which was listed on the International Search Report and indicated by the Patent Office in the Notification of Defective Response dated August 28, 2002, as having been received from the International Bureau.

The applicants also note that Form PCT/DO/EO/903, mailed by the Patent Office on October 3, 2003, confirms that the International Search Report and copies of the references cited in the International Search Report had been received by the Patent Office. The undersigned notes that MPEP § 609(ii) states as follows:

"the Examiner will consider the documents cited in the International Search Report in a PCT National Stage application when the Form PCT/DO/EO/903 indicates that both the International Search Report and a copy of the documents were present in the National Stage file. In such a case, the Examiner should consider the documents from the International Search Report and indicate by a Statement in the Office Action that the information has been considered. There is no requirement that the Examiner list the documents on a PTO-892 Form..... in order to have the references printed on [a] resulting patent, separate listing, preferably on a PTO-1449 Form, must be filed...."

The undersigned has filed the PTO-1449 Form listing the documents cited in the International Search Report which the Patent Office has confirmed has been received along with the documents and Form PCT/DO/EO/903. Nothing further is believed to be required.

Further clarification is requested as to why the Examiner will not consider these references and what further may be required to confirm in the record that the documents have been considered and will be listed on the face of any patent issuing from this application.

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Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____



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